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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WON, MICHAEL YOUNG

ART UNIT	PAPER NUMBER
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2155

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/918,279

Applicant(s)

KAYE, EVAN JOHN

Examiner

Michael Y. Won

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-12,14-21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-12,14-21 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment filed November 29, 2006.
2. Claims 3, 8-10, and 14-18 have been amended and claims 1 and 22 have been cancelled with this amendment.
3. Claims 3-12, 14-21, and 23 have been examined and are pending with this action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

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Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 8, 10-12, 14-20, and 23 have been rejected under 35 U.S.C. 102(e) as being anticipated by Franklin et al. (US 6,125,352 A).

INDEPENDENT:

As per **claim 18**, Franklin teaches a method for facilitating purchases of gift items made available for purchase by a host server, comprising the steps of:

a) downloading to a client machine a component (see col.1, lines 15-18 & 53-58 and col.16, lines 25-27: "loading structures in memory from data stored on the hard disk or other fixed media") from the host server, the component including a selection template which coordinates with information in an address book which is accessible from the client machine (see col.26, lines 3-6: "the commerce client 122 loads the address book object");

b) retrieving into the component at least a set of names of potential gift recipients from the address book (see col.26, lines 7-15: "Friendly Name");

c) retrieving from the host server a set of gift items, each of which is associable with one or more names in the set of potential gift recipients (see col.27, lines 40-50: "sorted by merchant... " and lines 51-60: "AddressFriendlyName... shipped to different locations");

d) displaying in a browser operating at the client machine (see col.29, lines 1-2) a matrix of selection cells which is defined by intersecting rows and columns, one of the

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rows and columns denoting the set of gift items and the other denoting the names in the set of potential gift recipients (see col.27, lines 40-60: "first product group associated with a first merchant... subgroups according to the value of the PaymentFriendlyName... third subgrouping... based on the values of AddressFriendlyName"); and

e) enabling the user to associate names in the set of potential gift recipients with gifts in the set of gift items by interacting with one or more selection cells so as to select one or more cells (see col.27, lines 34-36: "the consumer is prompted to confirm the purchase request") and thereby define a set of intended gift recipients (see col.27, lines 40-60: "orders which could be submitted to one merchant, cause payment from different payment sources and assist the merchant in shipping products to different locations").

As per **claim 23**, Franklin teaches a method for facilitating purchases of gift items that are made available for purchase from a host server, comprising the steps of:

using a browser executing at a client machine (see col.2, lines 35-41: "in conjunction with a standard Web browser" and col.7, lines 45-48), adding the gift items available for purchase from the host server to an electronic shopping basket (see col.8, lines 64-66: "Add Items to Shopping Basket"); and

in connection with a checkout by a user at the client machine:

a) prompting the user with a permission request to access (see col.9, lines 42-46: "The consumer then authorizes access to the payment source and address information stored on the consumer computer by entering a password";

col.10, lines 41-48; and col.12, lines 24-48) a particular address book including at least a set of names (see col.9, line 63-col.10, line 1: "an address book in which shipping address can be recorded" and col.26, lines 7-15: "Friendly Name");

b) testing for the presence of a component on the client machine (implicit: see col.1, lines 15-18 & 53-58 and col.16, lines 25-27: "loading structures in memory from data stored on the hard disk or other fixed media"); and

c) in the event that the component is present on the client machine:

1) retrieving at least the set of names from the particular address book using the component (see col.26, lines 7-15: "Friendly Name");

2) constructing a selection form which presents a matrix of selection cells, wherein each selection cell is at the intersection of a particular one of the added gift items from the electronic shopping basket and a particular name from the retrieved set of names (see col.27, lines 40-60: "first product group associated with a first merchant... subgroups according to the value of the PaymentFriendlyName... third subgrouping... based on the values of AddressFriendlyName");

3) displaying in the browser the constructed selection form (see col.29, lines 1-2);

4) enabling the user at the client machine to associate from within the selection form at least the particular one of the gift items with at least the particular name (see col.27, lines 34-36: "the consumer is prompted to confirm the purchase request") to thereby define a set of intended gift

recipients (see col.27, lines 40-60: "orders which could be submitted to one merchant, cause payment from different payment sources and assist the merchant in shipping products to different locations"); and

5) forwarding to the host server the set of intended gift recipients including at least the particular name retrieved from the particular address book (see col.29, lines 5-16: "HTTP Post message").

DEPENDENT:

As per **claims 8 and 20**, which depend on claim 18, Franklin further teach wherein the interacting with one or more selection cells comprises selecting a radio button, which is displayed at the client machine (see col.29, lines 1-4).

As per **claim 10**, which depends on claim 18, Franklin further teaches of including the additional step, once the set of intended gift recipients has been defined, of presenting at the client machine a shipping form which is automatically populated with the names and shipping information for each of the intended gift recipients, the shipping information including a respective address which is retrieved from the address book for each of the intended gift recipients (see col.14, lines 38-48 and col.23, lines 7-14).

As per **claim 11**, which depends on claim 10, Franklin further teaches of including the additional step of providing the names and shipping information of the intended gift recipients to the host server (see col.4, lines 57-61: "A network connection

is established for the commerce client to communicate the order to the commerce server”).

As per **claim 12**, which depends on claim 10, Franklin further teaches wherein the shipping information for at least one of the intended gift recipients is populated in the shipping form free of manual entry by the user (implicit: see col.12, lines 25-48).

As per **claim 14**, which depends on claim 18, Franklin further teaches wherein the address book is retrieved from the client machine (see Fig.4).

As per **claim 15**, which depends on claim 18, Franklin further teaches wherein the address book is retrieved from a third party server (see col.4, lines 59-61 and col.15, lines 47-51: “selectively stored”).

As per **claim 16**, which depends on claim 18, Franklin further teaches including the additional step of executing the component at the client machine, which performs the retrieving and combining steps (see claim 1 rejection above).

As per **claim 17**, which depends on claim 18, Franklin further teaches including the additional step of displaying any prior gift item associations that were made in a previous session with the host server (see col.21, line 57-col.22, line 7) so as to advise a user of a possible repeat gift item purchase (subjective).

As per **claim 19**, which depends on claim 18, Franklin further teaches of including the additional step of providing the set of intended gift recipients to the host server free of manual entry of the names of the intended gift recipients (implicit: see col.12, lines 25-48).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-7, 9, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al. (US 6,125,352 A) in view of Chui et al. (US 6,657,702 B1).

As per **claim 3**, which depends on claim 18, Franklin does not explicitly teach of including the additional step of enabling the user at the client machine to associate a message with a potential gift recipient.

Chui teach of including the additional step of enabling the user at the client machine to associate a message with a potential gift recipient (see col.3, lines 13-15; col.11, lines 30-34; and col.14, lines 52-65).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Franklin in view of Chui by implementing enabling the user at the client machine to associate a message with a potential gift recipient. One would be motivated to do so because anyone of any art knows that messages are almost always accompanied with a gift.

As per **claim 4**, which depends on claim 3, Franklin does not explicitly teach wherein the message is entered by the user.

Chui teaches wherein the message is entered by the user (see Fig.5, #522; col.11, lines 30-34: "personal message"; and col.15, lines 40-45).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Franklin in view of Chui so that the message is entered by the user. One would be motivated to do so because the gift is purchased by the user.

As per **claim 5**, which depends on claim 3, Franklin does not explicitly teach wherein plural messages can be entered by the user, and wherein the user can select any one of the plural messages for associating with a particular recipient in the set of potential gift recipients.

Chui further teaches wherein plural messages can be entered by the user, and wherein the user can select any one of the plural messages for associating with a particular recipient in the set of potential gift recipients (see Fig.5, #522; col.11, lines 30-34: "personal message"; and col.15, lines 40-45).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Franklin in view of Chui so that plural messages can be entered by the user, and wherein the user can select any one of the plural messages for associating with a particular recipient in the set of potential gift recipients. One would be motivated to do so because anyone of any art knows that messages are almost always accompanied with a gift and because the gift is purchased by the user.

As per **claim 6**, which depends on claim 3, Franklin further teach wherein plural messages are displayed at the client machine, any one of which is associable with a particular recipient in the set of potential gift recipients (see col.29, lines 10-17)

As per **claim 7**, which depends on claim 3, Franklin further teaches wherein the selection form further includes the at least one message which the user is enabled to associate with the potential gift recipient.

Chui teach wherein the selection form further includes the at least one message which the user is enabled to associate with the potential gift recipient (see claim 5 rejection above).

As per **claims 9 and 21**, which depend on claims 1 and 18, respectively, Franklin does not explicitly teach wherein interacting with one or more selection cells comprises selecting a checkbox, which is displayed at the client machine.

Chui teaches wherein interacting with one or more selection cells comprises selecting a checkbox, which is displayed at the client machine (see col.18, lines 20-24).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Franklin in view of Chui by implementing selecting a checkbox, which is displayed at the client machine. One would be motivated to do so because one of ordinary skill in the art would employ buttons, check boxes or any means of indicating a selection and because Franklin teaches of prompting users (see col.27, lines 34-36).

Response to Arguments

6. Applicant's arguments filed November 29, 2006 have been fully considered but they are not persuasive.

Applicant(s) argue that although Franklin teaches of a component object model, which cooperates to enable a purchase transaction, "these objects do not cooperate to define a selection template as claimed" because Franklin does not specifically teach of a "matrix of selection cells".

In response Franklin clearly teaches of a matrix of selection cells with respect to the functionality involved in the broadly recite claims. Franklin teaches of selectable group of merchants, which are further divided into product groups, which are further divided into subgroups of payment methods, which are further divided into subgroups of names correlating to shipping addresses (see col.27, lines 40-60). These groups are displayed to the user and prompt the user to finalize the selections for purchase (see col.27, lines 34-26), which clearly teaches "interacting with selection cells of matrix". Therefore, the "list of unpurchased products" is clearly the same as a "matrix of selection cells" because the functionality remains the same.

Because Franklin teaches a "matrix of selection cells", Franklin teaches a selection template (i.e. commerce client 122) according to the argument above.

Conclusion

7. For the reasons above claims 3-12, 14-21, and 23 have been rejected and remain pending with this action.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

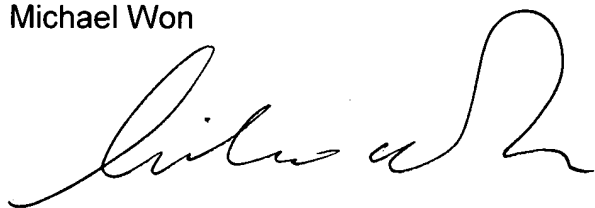
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Y. Won whose telephone number is 571-272-3993. The examiner can normally be reached on M-Th: 7AM-5PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael Won



January 10, 2007



SALEH NAJJAR
SUPERVISORY PATENT EXAMINER